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EXAMINER

JEANTY, ROMAIN

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/340,566

Applicant(s)

TURK ET AL.

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12, 13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 13, 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16-23 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communications filed June 9, 2003. By the amendment, claims 12-13 and 15 have been amended, and claim 14 has been canceled. **Claims 12-13 and 15** are pending in the application.

### **Response To Amendment**

2. Applicants' amendment to claims 13-15 has overcome the objection.

3. The Supplemental Declaration and Power of Attorney submitted has overcome the objection.

### ***Election/Restrictions***

4. This application contains claims 16-23 drawn to an invention nonelected with traverse in Paper No. 24. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### **Specification**

5. The amendment filed on June 9, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the total amount of fungible precious metal represented by the plurality of electronic data files is less than or equal to the quantity of fungible precious metal stored in the secure facilities..

Applicant is required to cancel the new matter in the reply to this Office Action.

### **Claim Rejections - 35 USC § 112**

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites the limitations "...the total amount of fungible precious metal represented by the plurality of electronic data files is less than or equal to the quantity of fungible precious metal stored in the secure facilities" is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention.

For examination purposes, the examiner interprets the claim limitations in light of the 112 first rejection.

Since claims 13, and 15 depend on claim 12, they suffer the same deficiency.

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. *Claims 12 and 13* are rejected under 35 U.S.C. 102(b) as being anticipated by **Rosen** (US Pat. No. 5,453,601), previously submitted by the Applicants.

Rosen teaches an electronic (i.e., computer-based) monetary system comprising an electronic note that is detected by the computer system (i.e., computer program code), the electronic data file representing the electronic note containing:

- a Note identifier (col. 19, ln. 65) uniquely identifying the electronic note file,
- an amount or value of the electronic note (col. 20, ln. 4) that represents the amount of the demand deposits (e.g., cash) held at the Issuing Bank that is backing the electronic note,
- a date-of-issue for the electronic note (col. 19, ln. 66), and
- a digital signature used to authenticate the electronic note file (col. 20, ln. 27).

It is the premise of this Office Action that the "demand deposits" that are held at the Issuing Bank that "backs" every electronic note issued by the Issuing Bank is considered to be a "valuable commodity" because demand deposits are anything deposited at a financial institution that can be withdrawn at any time (i.e., upon demand). Demand deposits usually refer to cash but

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are not exclusive to cash only. Further, cash (i.e., currency) itself is considered to be a "valuable commodity" since currencies themselves are traded/exchanged on the currency exchange just like any other commodity. Hence, applying the broadest reasonable interpretation of the claims, it is respectfully submitted that Rosen anticipates the limitations of claims 12 and 13 as currently recited.

*Applicants have amended claim 12 to recite newly added limitations (...the total of amount of fungible precious metal represented by the plurality of electronic data files is less than or equal...), however, the newly added limitations are not supported by the specification.*

10. **Claims 12 and 13** are rejected under 35 U.S.C. 102(e) as being anticipated by either **Doggett et al.** (US Pat. No. 5,677,955) or **Simon** (US Pat. No. 5,768,385).

**Doggett et al.** teaches a computer-based transaction system that generates electronic data containing:

- an identification number of the electronic data (col. 10, ln. 6),
- an amount of a valuable commodity (i.e., cash) that the electronic data represents (col. 10, ln. 8),
- a date the electronic data was issued (col. 6), and
- a digital signature used to authenticate the electronic data (col. 10, ln. 12).

**Simon** teaches a computer-based transaction system that generates electronic cash, the electronic data file containing: - a random number unique to the electronic data (col. 5, ln. 60) to prevent double spending (col. 6, ln. 65),

- an amount of a valuable commodity (i.e., cash) that the electronic data represents (col. 6, ln. 1),

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- a date of issue (col. 10, ln. 24), and
- a digital signature used to authenticate the electronic data (col. 6, lns. 1-2).

Again, it is respectfully submitted that cash (i.e., currency) itself is considered to be a "valuable commodity" since currencies themselves are traded/exchanged on the currency exchange just like any other commodity. Hence, applying the broadest reasonable interpretation of the claims, it is respectfully submitted that both Doggett et al. and Simon anticipate the limitations of claims 12 and 13 as currently recited.

*Applicants have amended claim 12 to recite newly added limitations (...the total of amount of fungible precious metal represented by the plurality of electronic data files is less than or equal...), however, the newly added limitations are not supported by the specification.*

11. **Claims 12-13 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lindsey et al.** (US Pat. No. 5,285,383).

As to claims 12 and 13 Lindsey et al. teaches a computerize system for trading valuable commodities. Lindsey teaches the system using the example of cotton trading but also teaches that

...the principles and concepts of the invention can be utilized in other environments, and are not thereby limited to commodities or the equipments shown (the commodities can be fungible precious metal) (col. 3, lns. 40-44).

In particular, Lindsey et al. teaches generating electronic data files that uniquely identifies the commodity to be traded (col. 4, lns. 62-65; col. 17, lns. 64-68), the amount of the commodity that the electronic data represents (col. 5, lns. 6-8; col. 18, ln. 50), and date of creating the electronic file (col. 20, ln. 6). Lindsey et al. does not specifically teach using digital signatures

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to authenticate the electronic data file. However, Lindsey et al. does teach validating the data based on various data cross-checking techniques (col. 5, lns. 59-60; col. 26, lns. 18-20).

Examiner takes Official Notice that digital signatures/certificates authenticating electronic trading data is old and well known to one of ordinary skill in the art. Therefore, it would have been obvious for one with ordinary skill in the art at the time the present invention was made to have used digital signatures to verify authenticity of the electronic data file representing the commodities to be traded generated in Lindsey et al. because digital signatures are precisely what those skilled in the computer security art use in effectuating the validation techniques as described in Lindsay et al. Almost all electronic trading and exchange systems employed digital signatures at the time the present invention was made to verify that the electronic trade tickets (i.e., the electronic "titles" generated in Lindsey et al.) are authentic for purchases to rely on in performing the trades.

*Applicants have amended claim 12 to recite newly added limitations (...the total of amount of fungible precious metal represented by the plurality of electronic data files is less than or equal...), however, the newly added limitations are not supported by the specification.*

#### **Response to Arguments**

12. Applicant's arguments with respect to claims 12-13, and 15 are considered but not persuasive.

With respect to Applicants' objection to new matter "Applicant's attempt to now combine the subject matter into one specification in the present application finds no support in the disclosure as originally filed", the examiner notes that applicant can not add or amend the specification to include any subject matter more than what's contained in the U.S. Patent



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Application No. 08/465,430, now U.S. Patent No. 5,671,364 (herein referred to as “the ‘430 application”) and U.S. Patent Application 08/921,760, now U.S. Patent No. 5983207 (herein referred to as “the ‘760 application”) since the present application is filed as a **Divisional** application of the ‘760 application. Applicant is respectfully requested to identify the newly added features in all CIP applications in order for the examiner to determine the priority dates and to identify any new matter in the specification of the present application.

Further, with respect to applicants’ request to proceed with examination of claims 16-23, these claims were originally withdrawn from consideration based on a Restriction Requirement by original presentation. The fact that claims 16-23 were not examined, has to do with the Restriction Requirement not the new matter added in the specification. Applicants respectfully required to cancel claims 16-23 in response to this Final Office Action.

With respect to Applicants’ arguments that the teachings of the ‘430 application were explicitly and clearly incorporated by reference in the ‘760 application and incorporation by reference is a well-known practice that is explicitly approved of by the United States Patent Office. The Examiner respectfully disagrees with Applicants’ arguments because it is noted that the present application was filed as a Divisional application, not a CIP of the ‘760 application.

Applicants further argue on page that claim 12 has been amended to incorporate the limitations of claim 14, as well as other limitations and Applicants respectfully submit that the rejection of claims 12 and 13 under 35 U.S.C. § 102(b) is moot. In response, the examiner respectfully disagrees because the added limitations in claim 12 are considered as new matter. Note objection to the specification above.

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Applicants further argued on pages 6, 7 and 8 that in order to obviate payment risk, all claim of the present invention require at least the followings elements” (1) an inventory.... (2) a computer system for creating “ecoins denominated in units of the commodity, and (3)... is less than or equal to... and applicant respectfully submit that neither Rosen, Dogget et al., Simon or McAndrews, either alone or in combination, discloses or suggest any of these highlighted elements. However, it is noted that the limitations that the applicants are relied upon “... payment risk....an inventory... payment risk...creating “ecoins” denominated in units of the commodity ” is not disclosed in the claim. Therefore, applicants’ arguments with regard to these limitations are not found to be persuasive.

Applicants further argued on page 9 that that there is no motivation in the systems of Rosen, Dogget et al, and/or Simon to provide a system which is 100% backed. Again, it is noted that the limitations that the applicants are relied upon “providing 100% backing ” is not disclosed in the claim. Therefore, applicants’ arguments with regard to these limitations are not found to be persuasive.

Applicants further argued on pages 9 and 10 that that McAndrews does not present that possibility that the digital currency could be backed 100%, and McAndrews express absolutely no motivation for doing so, McAndrews is not concerned with eliminating payment risk inherent with using national currencies. Again, it is noted that the limitations that the applicants are relied upon “providing 100% backing, and eliminating payment risk inherent with using national currencies” is not disclosed in the claim. Therefore, applicants’ arguments with regard to these limitations are not found to be persuasive.

Applicants further argued that Lindsey et al in not in any way concerned with permitting gold or other commodities to circulate as currency or with payment risk. Again, it is noted that the limitations that the applicants are relied upon "... permitting gold or other commodities to circulate and eliminating payment risk inherent with using national currencies" is not disclosed in the claim. Therefore, applicants' arguments with regard to these limitations are not found to be persuasive. It is further noted that the examiner interpretation of the claims, wherein the examiner explicitly stated passages in the cited reference and taken of Official Notice were not even addressed.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Ferstenberg et al (U.S. Patent No. 5,873,071) discloses the idea of using fungible commodities in a trading.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm. If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to: (703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington VA, Seventh floor receptionist.

A handwritten signature in black ink, appearing to read 'Romain Jeanty', is written over the printed name.

Romain Jeanty

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August 25, 2003